

### **Remarks**

Claims 1-12 are pending in the instant application. Claims 1-12 have been amended to correct their form. Claim 1 is independent.

The Office Action objects to claim 1 because the phrases “for adjusting location of said demetallization roll” and “to move said demetallization roll” are allegedly not clear and precise because the specification indicates that the speed and not the position of the roll is adjusted by the indexing means. Applicant has amended claim 1 to recite that the indexing means is for adjusting a speed of the demetallization roll to align the demetallization roll to be in register with the web material.

### **Rejection Under 35 U.S.C. § 112, first paragraph**

Claims 1-12 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification to enable one of ordinary skill in the art to make or use the invention. Specifically, the Office Action states that “(i)t is not clear how the changing speed of the roller and film causes the demetallization to occur in register with a pattern since the pattern is determined by the pattern on the etchant print-roller and not the roller speed”.

Claim 1 has been amended to clarify that the web is a pre-printed web having a predetermined web pattern. In particular, claim 1 has been amended to recite “(a) method for selective demetallization of a *pre-printed* web, ... including indexing means for adjusting a

speed of the demetallization roll, ...causing the indexing means to *align the demetallization roll to be in register with the pre-printed web*". In other words, the web pattern is pre-printed on the web prior to demetallization, rather than being determined by the etchant print-roller, as suggested by the Examiner.

In view of the above, Applicant respectfully requests the withdrawal of the rejection of claims 1-12 under 35 U.S.C. § 112, first paragraph.

#### **Rejection Under 35 U.S.C. § 103(a)**

Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson U.S. Patent No. 4,959,120 ("Wilson") in view of Mallik U.S. Patent No. 5,128,779 ("Mallik") and further in view of Hurley et al. U.S. Patent No. 4,745,288 ("Hurley").

Wilson discloses a selectively demetallized metal film having a graduated optical density from one area to another. The amount of metal present in the film can vary gradually and continuously or in stages resulting in a series of bands or patches, wherein different amounts of the metal are removed from the film in different areas, preferably by exposing the metal film in different areas to different amounts of an etchant. The Office Action states that Wilson fails to teach the use of a web having a pre-printed image. To cure this deficiency, Mallik is employed to teach a web having a pre-printed image. However, the Office Action further states that Wilson in view of Mallik fails to teach an automated means for demetallizing the web in registration with a pre-printed image. Hurley is used to attempt to cure the deficiencies of Wilson in view of Mallik.

Hurley is directed to a registration controller for sensing the presence and location of registration marks on a web as the web passes a scanner, and for generating a signal for use in controlling downstream operations such as cutting and printing. Although Hurley teaches the use of registration marks for downstream cutting and printing operations, it has nothing to do with demetallizing a web in registration with a pre-printed image, as required by claim 1 of the present invention. In particular, the Office Action states "Wilson in view of Mallik does not show an automated means for demetallizing the web in registration with a pre-printed image." Applicant respectfully asserts that Hurley fails to teach such an automated means for demetallizing the web in registration with a pre-printed image, and therefore utterly fails to cure the deficiencies of Wilson and Mallik.

In view of the above, it is respectfully submitted that Wilson in view of Mallik and further in view of Hurley fails to render obvious claim 1 of the instant invention. Claims 2-12 are not rendered obvious by their dependence from independent claim 1.


### Conclusion

Based on the foregoing, favorable reconsideration and allowance of claims 1-12 is solicited. If necessary, the Commissioner is hereby authorized in this and concurrent replies to charge payment (or credit any overpayment) to Deposit Account No. 50-0683 for any additional required fees.

Respectfully submitted,

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David E. Heisey

Attorney for Applicant(s)

Reg. No. 42,651

c/o LUCE, FORWARD, HAMILTON  
& SCRIPPS LLP  
600 West Broadway, Suite 2600  
San Diego, California 92101  
Telephone No.: (619) 233-2984  
Telephone No.: (619) 645-5391